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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/890,290	07/27/2001	Kwok-Shun Cheng	MCA-437PC/US	8923
7590 05/19/2004				
Mykrolis Corporation 129 Concord Road Billerica, MA 01821-4600			EXAMINER MENON, KRISHNAN S	
			ART UNIT 1723	PAPER NUMBER
DATE MAILED: 05/19/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/890,290

Applicant(s)

CHENG ET AL.

Examiner

Krishnan S Menon

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1723

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 05 May 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 05 May 2004. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.  
2. ☒ The proposed amendment(s) will not be entered because:  
(a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☒ they raise the issue of new matter (see Note below);  
(c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see attachment.

3. ☒ Applicant's reply has overcome the following rejection(s): 112 first para of final action of 1/5/04.  
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_.  
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.  
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_

Claim(s) objected to: \_\_\_\_\_

Claim(s) rejected: 1-32.

Claim(s) withdrawn from consideration: \_\_\_\_\_

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.  
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.  
10. ☐ Other: \_\_\_\_\_

***Specification***

The attempt to incorporate subject matter into this application by reference to 60/117,852 in page 13 of the specification is improper because the subject matter being incorporated is considered essential, because such subject matter is being claimed by amendment to the claims. Incorporation of essential subject matter from references other than published US patents is improper according to MPEP 608.01(p). See MPEP 608.01(p) for the disclosure requirements of essential subject matter.

***Response to Amendment***

The newly added limitation, "one or more membrane primarily formed of fibrils" is considered new matter because this subject matter is not described in the specification or in the references incorporated therein in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of this subject matter. The 60/117,852 reference incorporated in the specification and the corresponding WIPO publication WO 00/44484 do not describe the membrane as primarily made of fibrils. WO 00/44484 and 60/117,852 describe only the inside surface of sample 8 in example 1 (example 1 has 8 samples) as having the fiber-like structure from fig 7. The pictures the other sample described as having the fiber like structure does not appear fiber-like as in fig 7. This fiber-like structure does not resemble the prior-art recognized fibril structure. Therefore, there insufficient basis for claiming "primarily formed of fibrils" from this data. This subject matter is also new

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issue requiring further consideration and/or search. Therefore, amendment will not be entered.

Applicant's arguments along with the submission of the relevant pages of the incorporated reference have overcome the 112 first paragraph rejection in the final action of 1/5/04.

### ***Response to Arguments***

Applicant's arguments filed 5/5/04 have been fully considered but they are not persuasive.

Applicant's arguments are based on the newly introduced issue, "the membrane being primarily formed of fibrils". Applicant argues that fibril means fiber-like structure. The dictionary meaning of "fibril" is a small filament or fiber; as one of the fine threads into which a striated muscle fiber can be longitudinally split (Webster's Collegiate Dictionary, 10<sup>th</sup> Ed).

Meaning of Fibril in analogous art are represented by:

Yen (US 5032274): "...microporous membranes was described in U.S. Pat. No. 4,539,256. Adjacent particles throughout the material are separated from one another to provide micropores and which particles are connected to each other by a plurality of fibrils." (col 2 lines 33-36)

Shipmann (US 4,539,256): "Adjacent thermoplastic particles within the article are connected to each other by a plurality of fibrils consisting of the thermoplastic polymer.

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The fibrils radiate in three dimensions from each particle"(abstract). Fig 6 gives a photograph of the fibrils interconnecting particles.

Gore (US 4,096,227) – Figure 1 depicts the fibril structure.

In contrast, the figure 7 of the provisional application 60/117,852 (published as Fig 7 in WO 00/44484) the applicant discloses as having the fiber-like structure depicts circular brush-stroke like structure.

Claim 1 of the Kawai ref recites "A porous film membrane consisting essentially of a layer of a porous polytetrafluoroethylene resin particle bond structure substantially devoid of a fibrillated portion". This should be considered in conjunction with the Gore ref Kawai cites as prior art, which teaches fibrillated structure as having fibrils interconnecting particles, and, Kawai is clearly talking about having "substantially devoid of" such fibrils in the claim.

Since the applicant's process and Kawai process are similar (phase inversion), and both use similar materials, Kawai also is inherently expected to have structure similar to what is depicted in the Fig 7 (or for that matter, 5,6, 8, etc.) of WO 00/44484. Also one of ordinary skill in the art would recognize the similarities between the SEM pictures of the Kawai ref and Fig 7 of WO 00/44484. Applicants' arguments that Kawai ref does not explicitly teach fibrils, therefore, is not persuasive to overcome the rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Krishnan S Menon whose telephone number is 571-272-1143. The examiner can normally be reached on 8:00-4:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda L Walker can be reached on 571-272-1151. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Krishnan Menon  
Patent Examiner

  
W. L. WALKER  
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TECHNOLOGY CENTER 1700